

**REMARKS**

This Application has been carefully reviewed in light of the Office Action mailed August 1, 2005. Claims 1-22 were pending in the Application. In the Office Action, Claims 1-13 were rejected. In order to expedite prosecution of this Application, Applicants amend Claim 1. Thus, Claims 1-22 remain pending in the Application. Applicants respectfully request reconsideration and favorable action in this case.

In the Office Action, the following actions were taken or matters were raised:

**SECTION 103 REJECTIONS**

Claims 1-13 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,185,900 issued to Rabindran et al. (hereinafter "*Rabindran*") and further in view of U.S. Patent No. 4,658,299 issued to Tanaka et al. (hereinafter "*Tanaka*"). Applicants respectfully traverse this rejection.

Of the rejected claims, Claims 1 and 9 are independent. Applicants respectfully submit that neither *Rabindran* nor *Tanaka*, alone or in combination, discloses, teaches or suggests the limitations of independent Claims 1 and 9.

Independent Claim 1, as amended, recites "a template body" and "an actuation device disposed on the template body for actuating a switch, actuation of the switch based on a type of media supported by the template" (emphasis added). Applicants respectfully submit that neither *Rabindran* nor *Tanaka*, alone or in combination, discloses, teaches or suggests "actuation of [a] switch based on a type of media supported by the template" as recited by Claim 1 (emphasis added). *Rabindran* appears to disclose a microfiche carrier that is notched on one corner such that when the notched portion of the carrier is positioned below two photo sensors 424 and 426 of the microfiche reader, light directed upwardly from a location below the carrier is either blocked or transmitted, thereby resulting in different sensor 424 and 426 outputs indicating whether the carrier has been inserted into the reader (*Rabindran*, column 6, lines 21-54, figures 7 and 8). Thus, *Rabindran* does not disclose, teach or even suggest "actuation of [a] switch based on a type of media supported by the template" as recited by

Claim 1 (emphasis added). Moreover, *Tanaka* does not appear to remedy at least this deficiency of *Rabindran*. Accordingly, for at least this reason, independent Claim 1 is patentable over the cited references.

In rejecting independent Claim 9, the Examiner has not provided sufficient reasoning or made any assertions as to why he believes that the portions of *Rabindran* referred to by the Examiner disclose particular limitations of Claim 9. The Examiner merely provides a general recitation of column and line numbers of *Rabindran*, leaving Applicants guessing as to the Examiner's intended meaning. For example, with respect to Applicants' Claim 9 recitation of "an adapter housing," "a signal transmission mechanism," and "a switch disposed on the housing and actuatable by an actuation device on a template," the Examiner merely states "figs. 7 and 8, col. 5, line 61 through col. 6, line 36" (Office Action, page 3) without indicating which components of *Rabindran* the Examiner is relying on to purportedly teach, for example, "an adapter housing," "a signal transmission mechanism," or "a switch . . . actuatable by an actuation device on a template" as recited by Claim 9. Because the Office Action fails to provide any indication of which components of *Rabindran* are relied upon by the Examiner to purportedly teach the limitations of Claim 9, Applicants find it difficult, if not impossible, to adequately address the Examiner's rejection. Applicants request the Examiner to clearly indicate which components of *Rabindran* the Examiner is relying on to purportedly teach the limitations of Claim 9 so that Applicants may have a fair opportunity to address the Examiner's concerns.

Regardless, Applicants submit that the proposed combination of references does not disclose or even suggest each and every limitation of independent Claim 9. For example, independent Claim 9 recites a "transparent media adapter for a scanning system" comprising "an adapter housing," "a signal transmission mechanism disposed within the adapter housing" and "a switch disposed on the housing and actuatable by an actuation device on a template." As discussed above, the Examiner does not explicitly indicate which elements or structure the Examiner is relying on in *Rabindran* to purportedly teach specific elements recited by Claim 9 (Office Action, page 3). However, because *Rabindran* is generally directed toward a microfiche reader/printer, Applicants presume that the reader/printer device, as a whole, is

what the Examiner may have intended to correspond to the “scanning system” recited by Claim 9. Applicants also presume that the microfiche carrier of *Rabindran* is what the Examiner may have intended to correspond to the “transparent media adapter” recited by Claim 9. In the Office Action, the Examiner appears to rely on column 5, line 61 through column 6, line 36, of *Rabindran* as disclosing the limitations of Claim 9. Applicants respectfully disagree. As discussed above in connection with independent Claim 1, the portion of *Rabindran* referred to by the Examiner appears to be directed solely toward a microfiche carrier. Applicants respectfully point out to the Examiner that Claim 9 recites a “transparent media adapter for a scanning system” where the transparent media adapter comprises “a switch . . . actuatable by an actuation device on a template” (emphasis added). Applicants respectfully submit that the microfiche carrier of *Rabindran* cannot be construed to correspond to both the “transparent media adapter” and the “template” recited by Claim 9 as any such interpretation would amount to an improper claim construction. Accordingly, *Rabindran* does not disclose or even suggest “a transparent media adapter . . . [having] a signal transmission mechanism . . . [and] a switch . . . actuatable by an actuation device on a template” as recited by Claim 9. Moreover, *Tanaka* does not appear to remedy at least this deficiency of *Rabindran*. Accordingly, for at least this reason, independent Claim 9 is patentable over the cited references.

Claims 2-8 and 10-13 depend respectively from independent Claims 1 and 9. For at least the reasons discussed above, independent Claims 1 and 9 are in condition for allowance. Therefore, Claims 2-8 and 10-13 are also in condition for allowance, and Applicants respectfully request that the rejection of Claims 1-13 be withdrawn.

#### **ALLOWED CLAIMS**

Applicants thank the Examiner for indicating the allowability of Claims 14-22. Claims 14-22 remain unchanged. Therefore, Applicants respectfully submit that Claims 14-22 remain in condition for allowance.

**CONCLUSION**

Applicants have made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for other reasons clearly apparent, Applicant respectfully requests reconsideration and full allowance of all pending claims.

No fee is believed due with this Response. If, however, Applicant has overlooked the need for any fee due with this Response, the Commissioner is hereby authorized to charge any fees or credit any overpayment associated with this Response to Deposit Account No. 08-2025 of Hewlett-Packard Company.

Respectfully submitted,

By: James L. Baudino  
James L. Baudino  
Reg. No. 43,486

Date: 11-1-05

Correspondence to:  
L.Joy Griebenow  
Hewlett-Packard Company  
Intellectual Property Administration  
P. O. Box 272400  
Fort Collins, CO 80527-2400  
Tel. 970-898-3884